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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARL A. WRIGHT

Appeal 2008-3272
Application 09/766,934
Technology Center 3600

Decided: November 28, 2008

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
DAVID B. WALKER, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Carl A. Wright (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 24-29 and 32. Claims 30 and 31 have been withdrawn. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.¹

THE INVENTION

“The present invention relates generally to billing services; and, more particularly, to an automated method and system for the production of invoices, each invoice individually customized according to the preferences of the customer or client.” Specification 1:6-8.

The methods of the current art, however, fail to provide billing or account services particularized to a set of preferences. For example, a client may want specific fields of information that are not included under a general format to appear on the bill, or may prefer to have the information content displayed according to a particular layout.[Specification 2:1-4.]

The present invention addresses the shortcomings of the current art with an automated system and method that permits a provider of the same (hereafter, the provider) to customize invoice and bill formats as well as their contents for service organizations (hereafter, customers) or recipients of services (hereafter, clients). Under the system and method of the present art, a format customized to an individual account or client drives the invoice-generation process. This format consists of a plurality of invoice specification software objects that “pull” information on to the output page from other sources of data. Each specification software object acts as a machine to generate its goal output. A structured grouping of these objects working together generate the goal output, e.g. a telephone bill. [Specification 2:12-21.]

¹ Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed Sep. 17, 2007) and Reply Brief (“Reply Br.,” filed Dec. 17, 2007), and the Examiner’s Answer (“Answer,” mailed Oct. 17, 2007).

Claim 24, the sole independent claim, is reproduced below and illustrative of the subject matter on appeal.

24. A method of providing customized billing services, comprising the steps of:

providing a plurality of software objects, at least certain of which are capable of accessing an outside source, accessing one or more other software objects, or creating one or more new software objects, each object being operative to acquire and process data specific to a bill or the recipient thereof;

configuring a subset of the software objects to generate customized bill content for a particular bill recipient;

repetitively invoking the software objects of the subset, and any software objects that they access or create, until all of the objects have completed the data acquisition and processing actions required to generate the customized bill content; and

producing a bill by formatting the customized bill content for the particular bill recipient.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Ensel	US 6,493,685 B1	Dec. 10, 2002
Lakritz	US 2003/0140316 A1	Jul. 24, 2003

The following rejections are before us for review:

1. Claims 24-29 are rejected under 35 U.S.C. §102(e) as anticipated by Ensel.
2. Claim 32 is rejected under 35 U.S.C. §103(a) as unpatentable over Ensel and Lakritz.

ISSUES

The issue is whether the Appellant has shown that the Examiner erred in rejecting claims 24-29 under 35 U.S.C. §102(e) as anticipated by Ensel and claim 32 under 35 U.S.C. §103(a) as unpatentable over Ensel and Lakritz. The issue turns on two questions: (1) does Ensel describe software objects “capable of accessing an outside source, accessing one or more other software objects, or creating one or more new software objects, each object being operative to acquire and process data specific to a bill or the recipient thereof” (claim 24) and (2) does Ensel describe “repetitively invoking the software objects of the subset, and any software objects that they access or create, until all of the objects have completed the data acquisition and processing actions required to generate the customized bill content” (*Id.*).

PRINCIPLES OF LAW

Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 24-29 under §102(e) as being anticipated by Ensel.

Question (1): does Ensel describe software objects “capable of accessing an outside source, accessing one or more other software objects, or creating one or more new software objects, each object being operative to acquire and process data specific to a bill or the recipient thereof” (claim 24).

We have carefully reviewed the record and find that Ensel does *not* describe the limitation in claim 24 wherein software objects are “capable of accessing an outside source, accessing one or more other software objects, or

creating one or more new software objects, each object being operative to acquire and process data specific to a bill or the recipient thereof”.

Ensel describes a system for electronically creating, publishing, and distributing bills and processing payments from a biller’s customers. The system employs an Information Interface Provider (IIP). The IIP accesses raw billing data from the biller and formatted for particular customers. Col. 6, ll. 32-50. The formatting is performed using relational and object-oriented databases. Col. 4, ll. 17-38. Bills can be customized. Col. 11, ll. 4-5. Ensel describes various databases and corresponding files used to format the billing data. For example, there is a Summary file (element 210, Fig. 2) which contains data related to, for example, name and account number. Col. 10, ll. 53-55. There is also an E-bill file (element 215, Fig. 2) which contains data related to, for example, charges on a credit card. Col. 10, ll. 59-62. “In a preferred embodiment of the present invention, the E-bill file 215 is an object oriented file in which the E-bills are stored as objects.” Col. 10, ll. 63-65.

We have had a difficulty understanding precisely what in the Ensel system the Examiner is equating to the claimed “software object.” The Answer variously refers to Ensel’s IIP, databases, database files, and plug-ins without explicitly stating which of these is to be viewed as teaching the claimed “software object.” In that regard, the Examiner did not do a claim construction analysis leading to a finding as to the meaning the phrase “software object” should be given. *Compare In re Crish*, 393 F.3d 1253, 1256 (Fed. Cir. 2004). “A determination that a claim is anticipated under 35 U.S.C. § 102(b) involves two analytical steps. First, the Board must interpret the claim language, where necessary.... Secondly, the Board must

compare the construed claim to a prior art reference and make factual findings that ‘each and every limitation is found either expressly or inherently in [that] single prior art reference.’ *Celeritas Techs. Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998).”

The Examiner appears to have focused on Ensel’s database files. According to the Examiner, Ensel

disclose[s] that the sets of data used for bill contents are stored as a plurality of software objects, that is a subset of objects, in an object oriented E-bill file 215. This indicates that the subset of objects required for to provide bill contents for a particular bill recipient are instantiated, i.e. created or generated whenever invoked and in order to generate a plurality of data... [Answer 7-8.²]

The Appellant argues that Ensel’s objects (those the Examiner equates as objects) do not actually acquire and process data while also operative, for example, to access an outside source, as claimed. App. Br. 3 and Reply Br. 1. According to the Appellant, the objects to which the Examiner refers function simply as data. App. Br. 4 and Reply Br. 1.

The question is whether Ensel’s objects (e.g., E-bill file 215) are “capable of accessing an outside source ... [and] operative to acquire and process data specific to a bill” (claim 24) as the Examiner has argued. Taking the E-bill 215 file as an example, this file appears to be simply a database with no other function than to store data related to an E-bill. This view is supported by Ensel’s description of E-bill file 215: “database ... an

² We are aware of the Examiner’s reliance on the Board decision in prior appeal 2006-1123 where the panel indicated that the claim term “objects” implied they were “created or generated whenever invoked and in order to generate a plurality of data” (see p. 6 of the decision). However, the claims before us are different from those that were before the panel in 2006-1123.

E-bill file 215 containing both current and historical data related to E-Bills.” Col. 10, ll. 7-11. The E-bill file does not appear to include instructions giving the file a capability to perform the claimed functions. We note that the Examiner did argue that Ensel teaches “plug-ins” that can perform the formatting of the data in the databases. Answer 5. The salient passage in Ensel reads: “[a]pplication ‘plug-ins’ residing on application server 240 [which] accomplish the actual formatting of the electronic bills” (col. 13, ll. 57-62). The “plug-ins” Ensel describes do appear to have a function rendering them operative to process data specific to a bill. But what is not clear is whether they are also capable of “accessing an outside source ... [and] operative to acquire ... data specific to a bill” (claim 24). While the Ensel’s “plug-ins” *could* have those functions, there is no evidence that they would necessarily, i.e., inherently, have them. “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Hansgird v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939), quoted in *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991).

Accordingly, we agree with the Appellant that Ensel does not explicitly or inherently describe the claimed software objects which are “capable of accessing an outside source, accessing one or more other software objects, or creating one or more new software objects, each object being operative to acquire and process data specific to a bill or the recipient thereof” (claim 24).

Question (2): does Ensel describe “repetitively invoking the software objects of the subset, and any software objects that they access or create, until all of the objects have completed the data acquisition and processing actions required to generate the customized bill content” (claim 24).

The Examiner has taken the position that Ensel describes the claim limitation “*repetitively invoking the software objects of the subset, and any software objects that they access or create, until all of the objects have completed the data acquisition and processing actions required to generate the customized bill content.*” Answer 5. (Emphasis added) The Examiner relies on this sentence in Ensel: “The structure and content of the Summary file 210 and the E-Bill file 215 varies from biller to biller.” Col. 10, ll. 50-51. See Answer 8. The Examiner also argues that “Ensel’s system, that is IIP, in order to generate, format and present bills to customers accesses and acquires all the billing data needed to publish and present bills to customers and this will require repetitively invoking the different objects stored in different files [e.g., E-bill file 215].” Answer 11.

We disagree with the Examiner. The difficulty with the Examiner’s position is that it does not account for the fact that the claimed method repetitively invokes the software “until all of the objects have completed the data acquisition and processing actions required to generate the customized bill content” (claim 24) and that this refers to the “bill content for a particular bill recipient” (see step 2 of claim 24). Arguably, Ensel teaches repetitively invoking software objects, such as database E-bill 215. But there is no explicit teaching that a repetitious invoking of such a software object is performed until a customized bill content for a particular bill recipient is completed. Nor do we find that the Examiner has shown that such a step

would necessarily flow from the teachings of Ensel. When relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990). While Ensel's system may possibly be able to do what the method of claim 24 requires, anticipation cannot be based on probabilities.

Accordingly, we agree with the Appellant that Ensel does not explicitly or inherently teach “repetitively invoking the software objects of the subset, and any software objects that they access or create, until all of the objects have completed the data acquisition and processing actions required to generate the customized bill content” (claim 24).

Because we find that Ensel does not describe software objects “capable of accessing an outside source, accessing one or more other software objects, or creating one or more new software objects, each object being operative to acquire and process data specific to a bill or the recipient thereof” (claim 24) and “repetitively invoking the software objects of the subset, and any software objects that they access or create, until all of the objects have completed the data acquisition and processing actions required to generate the customized bill content” (*Id.*), we hold that the Appellant has shown that the Examiner erred in rejecting claim 24 as anticipated over Ensel. We reach the same conclusion as to dependent claims 25-29.

The rejection of claim 32 under §103(a) as being unpatentable over Ensel and Lakritz.

Claim 32 depends on claim 24. The Examiner did not address claim 24 in the context of §103 and thus appears to have maintained and relied upon the position taken in the context of §102 that Ensel describes the afore-discussed limitations in claim 24 (i.e., software objects “capable of accessing an outside source, accessing one or more other software objects, or creating one or more new software objects, each object being operative to acquire and process data specific to a bill or the recipient thereof” (claim 24) and “repetitively invoking the software objects of the subset, and any software objects that they access or create, until all of the objects have completed the data acquisition and processing actions required to generate the customized bill content” (*Id.*)). Because we have found that Ensel does not describe those steps and no articulation as to their obviousness over Ensel in view of Lakritz has been presented, we find that a prima facie case of obviousness of claim 32 has not been established.

CONCLUSIONS OF LAW

We conclude that the Appellant has shown that the Examiner erred in rejecting claims 24-29 under 35 U.S.C. §102(e) as being anticipated by Ensel and claim 32 under 35 U.S.C. §103(a) as being unpatentable over Ensel and Lakritz.

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DECISION

The decision of the Examiner to reject claims 24-29 and 32 is reversed.

REVERSED

vsh

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